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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVE MORSA

Appeal 2009-001803
Application 09/832,440
Technology Center 3600

Decided: February 25, 2010

20 Before ALLEN R. MACDONALD, Vice Chief Administrative Patent Judge,
21 MURRIEL E. CRAWFORD, and HUBERT C. LORIN, Administrative
22 Patent Judges.

24 CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

2 Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection
3 of claims 181, 184, 188-203, 206, 210-225, 228, 232-247, 250, 254-268, and
4 270-272¹. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

5 Appellant invented systems and methods for permitting an entity to
6 more effectively make use of a variety of available targeted benefits from a
7 plurality of goods, services, information, and value providers (Abstract).

8 Claim 181 under appeal is further illustrative of the claimed invention:

181. A system for permitting an individual to more effectively make use of a variety of available benefits from a plurality of benefit providers, wherein said benefits are offered specifically to those individuals eligible to receive said benefits, said system comprising

means for storing in a memory in the system benefit information, benefit provider information, and benefit correlation information;

means for inputting into said system a set of an individual's demographic, geographic, and psychographic data for said individual;

means for analyzing said individuals data, said benefit provider information, and said benefit correlation information to determine whether any benefit providers are offering potentially applicable benefits for said data and whether said data satisfies requirements for obtaining said potentially applicable benefits;

means for automatically generating a message to directly inform said individual, at least in part via a computer network, of any available benefits applicable to said individual's data.

¹ Claim 269 has been allowed. Claims 182, 183, 185-187, 204, 205, 207-209, 226, 227, 229-231, 248, 249, and 251-253 have been deemed allowable if rewritten into independent form.

1 The prior art relied upon by the Examiner in rejecting the claims on
2 appeal is:

3 PMA ("Peter Martin Releases HelpWorks Web Edition," Business
4 Wire, September 28, 1999).

5 The Examiner rejected claims 181, 184, 188-203, 206, 210-225, 228,
6 232-247, 250, 254-268, and 270-272.

7 We REVERSE.

8

SUMMARY OF THE DECISION

10 We reverse the rejections of the Examiner and enter new grounds of
11 rejection as to all pending claims pursuant to our authority under 37 C.F.R. §
12 41.50(b).

13 We enter a new ground of rejection of means-plus-function claims
14 181-202, 225-246, 270, and 271 under 35 U.S.C. § 112, second paragraph,
15 on the same basis set forth in *Aristocrat Techs. Austl. Pty Ltd. v. Inter. Game*
16 *Tech.*, 521 F.3d 1328 (Fed. Cir. 2008).

17 We enter a new ground of rejection of claims 203-224, 247-269 and
18 272 under 35 U.S.C. § 101, for failing to recite patentable subject matter,
19 because the recitation of machines does not impose meaningful limits on the
20 claims' scope.

21

22 I. Independent System Claims 181, 225, 270, and 271

ISSUE

24 Are independent system claims 181, 225, 270, and 271, which include
25 means-plus-function elements, in compliance with the requirements of 35
26 U.S.C. § 112, second paragraph? This issue turns on whether the

1 specification discloses structure that corresponds to the means recited in
2 these claims.

3

4 FINDINGS OF FACT

5 *Specification*

6 Appellant invented systems and methods for permitting an entity to, in
7 Appellant's own words, more effectively make use of a variety of available
8 targeted benefits from a plurality of goods, services, information, and value
9 providers (Abstract).

10 Standard components include conventional computers;
11 telecommunication and data communication services; and input and output
12 devices such as telephones, computer terminals, printers, and facsimile
13 machines (p. 8, ll. 23-25).

14 The Specification discloses that FIG. 1 is a block diagram of benefit
15 information distribution system 100. As illustrated, system 100 includes
16 user location 105, public switched telephone network 110, and central
17 controller 200 (p. 9, ll. 11-13).

18 Central controller 200 includes a conventional server computer system
19 that responds in near real time to requests for stored information. Central
20 controller 200 also executes software to store and manage benefit
21 information related to benefit providers; and to distribute the stored
22 information upon request (p. 10, ll. 1-4).

23 Central controller 200 receives the user's request via public switched
24 telephone network 110. Central controller 200 determines whether any
25 benefit information 140 corresponding to the received benefit information
26 request 130 exists. If so, central controller 200 retrieves the requested

1 benefit information from a benefit information database, and sends the
2 retrieved benefit information 140 to a user-specified location, such as user
3 output device 150 (p. 10, ll. 8-13).

4 The Specification also discloses that FIG. 2 is a block diagram of the
5 components of central controller 200. Central controller 200 is connectable
6 to a conventional network interface device 235, to connect central controller
7 200 to public switched telephone network 110. At the heart of central
8 controller 200 is CPU 205. CPU 205 connects to RAM 215, ROM 220, and
9 storage device 245. The Appellant asserts that CPU 205 represents one or
10 more suitable microprocessors (such as the Pentium processor manufactured
11 by Intel Corporation) or other electronic processing unit as is well known to
12 those skilled in the art. RAM 215 and ROM 220 are also conventional.
13 CPU 205, RAM 215, and ROM 220 are used in conventional ways to
14 process requests for benefit information in accordance with stored
15 instructions, *i.e.*, computer software (p. 10, ll. 20-28).

16 The various hardware requirements for the system can generally be
17 satisfied by any one of many commercially available high speed personal
18 computers offered by companies such as Dell, Compaq, IBM, or Apple.
19 Processing speed can be chosen to provide a suitable combination of speed
20 and cost effectiveness for the anticipated demands to be placed upon the
21 system. Alternatively, any other type of computer with sufficient processing
22 speed and memory capability can also be used (p. 12, ll. 6-13).

23 The system can be designed to operate with any specifically chosen
24 computer operating system such as Windows, MS-DOS, Linux, UNIX,
25 MAC OS, etc. In this regard, Appellant asserts that the system as disclosed
26 herein is an "application program" which can be designed to operate with

1 practically any conventional and commercially available computer operating
2 system. Further, Appellant further asserts that the system as designed herein
3 can be implemented by any programmer of ordinary skill in the art using
4 commercially available development tools for the operating systems
5 described above (p. 12, ll. 14-20).

6 The Specification further discloses that the specific input data
7 required to obtain benefit information can be varied as necessary, provided
8 such data is sufficient to allow processor 205 to accurately obtain correlated
9 benefit data. Information relation to entities, benefits, benefit providers, and
10 correlation data may be arranged in storage device 245 in any convenient
11 format or form. Appellant asserts that suitable data structures and search
12 routines for accomplishing this purpose are well within the knowledge of
13 those of ordinary skill in the art. Any suitable data structures and search
14 routine may be used, provided that it enables processor 205 to search for and
15 locate correlated benefit information applicable to a specific entity/user (p.
16 12, ll. 21-28).

17 Accordingly, the Specification discloses that no attempt shall be made
18 here to describe all of the various organizational methods and programming
19 techniques by which such information can be arranged and retrieved (p. 13,
20 ll. 1-3).

21

22 PRINCIPLES OF LAW

23 *35 U.S.C. § 112, sixth paragraph*

24 When a claim uses the term “means” to describe a limitation, a
25 presumption inheres that the inventor used the term to invoke §112, ¶ 6.

1 *Biomedino LLC v. Waters Technologies Corp.*, 490 F.3d 946, 950 (Fed. Cir.
2 2007).

3 For a patentee to claim a means for performing a particular function
4 and then to disclose only a general purpose computer as the structure
5 designed to perform that function amounts to pure functional claiming.
6 Because general purpose computers can be programmed to perform very
7 different tasks in very different ways, simply disclosing a computer as the
8 structure designated to perform a particular function does not limit the scope
9 of the claim to “the corresponding structure, material, or acts” that perform
10 the function, as required by § 112 ¶ 6. *Aristocrat Techs. Austl. Pty Ltd. v. Inter. Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008).

12 In a means-plus-function claim “in which the disclosed structure is a
13 computer, or microprocessor, programmed to carry out an algorithm, the
14 disclosed structure is not the general purpose computer, but rather the
15 special purpose computer programmed to perform the disclosed algorithm.”
16 *Aristocrat Techs. Austl. Pty Ltd. v. Inter. Game Tech.*, 521 F.3d 1328, 1333
17 (Fed. Cir. 2008) (quoting *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 1349 (Fed. Cir. 1999)).

19 “The corresponding structure for a § 112 ¶ 6 claim for a computer-
20 implemented function is the algorithm disclosed in the specification.”
21 *Aristocrat Techs. Austl. Pty Ltd. v. Inter. Game Tech.*, 521 F.3d 1328, 1333
22 (Fed. Cir. 2008) (quoting *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1249
23 (Fed. Cir. 2005)).

24 When a means-plus-function limitation is a computer programmed
25 with software to carry out the claimed function, a recitation of the
26 corresponding algorithm is required to provide sufficient disclosure of

1 structure under § 112 ¶ 6 to avoid indefiniteness under § 112 ¶ 2. *Aristocrat*
2 *Techs. Austl. Pty Ltd. v. Inter. Game Tech.*, 521 F.3d 1328, 1337-38 (Fed.
3 Cir. 2008).

4 Merely because an element does not include the word “means” does
5 not automatically prevent that element from being construed as a means-
6 plus-function element. A determination of whether Section 112, Para. 6
7 applies is decided on an element-by-element basis, based upon the patent
8 and its prosecution history. *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524,
9 531 (Fed.Cir. 1996) (*citing Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 957
10 (Fed.Cir.1983); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974
11 (Fed.Cir.1985)).

12

13 *Prior Art Rejections of Indefinite Claim*

14 Where claims do not particularly point out and distinctly claim the
15 invention as required by the second paragraph of 35 U.S.C. § 112, a § 103
16 rejection of the claims must be reversed as impermissibly involving
17 speculative assumptions as to the meaning of the claims. *In re Steele*, 305
18 F.2d 859, 862-63 (CCPA 1962).

19 If no reasonably definite meaning can be ascribed to certain terms in
20 the claim, “the subject matter does not become obvious - the claim becomes
21 indefinite.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

22

23 ANALYSIS

24 Using our authority under 37 C.F.R. § 41.50(b), we reject independent
25 system claims 181, 225, 270, and 271 under 35 U.S.C. § 112, second
26 paragraph, as being indefinite.

1 Independent claims 181 and 225 each recite four means-plus-function
2 elements. A presumption arises that the Appellant used the term “means” in
3 claims 181 and 225 to invoke 35 U.S.C. § 112, sixth paragraph. *See*
4 *Biomedino LLC v. Waters Technologies Corp.*, 490 F.3d at 950.

5 Some of the functions recited with means in independent claims 181
6 and 225 include “analyzing said individuals data...” and “automatically
7 generating a message....” Neither claim 181 nor claim 225 recites any
8 structure that would perform these claimed functions in their entirety. As
9 such, the presumption that §112, ¶ 6, applies is not rebutted by structure
10 recited in the claim.

11 37 C.F.R. § 41.37(c)(l)(v) normally requires that for “every means
12 plus function and step plus function as permitted by 35 U.S.C. § 112, sixth
13 paragraph, [Appellant] must [identify] the structure, material, or acts
14 described in the specification as corresponding to each claimed function.”
15 As best as we can ascertain, CPU 205 of central controller 200 of system
16 100 is the structure, material, or acts that correspondingly performs the
17 “analyzing” and “automatically generating” functions recited in independent
18 claims 181 and 225. As repeatedly admitted by Appellant in the
19 Specification, CPU 205 of central controller 200 is a conventional general
20 purpose computer. However, as set forth in *Aristocrat*, 521 F.3d at 1333, a
21 general purpose computer is not sufficient corresponding structure, material,
22 or acts to meet the requirements of 35 U.S.C. §112, ¶ 6. Instead, a special
23 purpose computer, or microprocessor, programmed to carry out an algorithm
24 is required. *See Id.*

25 The Specification does not disclose any specific algorithm that could
26 be implemented on a general purpose computer to carry out the “analyzing”

1 and “automatically generating” functions. Indeed, Appellant indicates that
2 “no attempt shall be made here to describe all of the various organizational
3 methods and programming techniques by which [benefit] information can be
4 arranged and retrieved.” Accordingly, the Specification fails to disclose the
5 algorithms that transform the general purpose processor to a special purpose
6 computer programmed to perform the recited “analyzing” and
7 “automatically generating” functions of claims 181 and 225.

8 As the Appellant has failed to disclose an algorithm, Appellant has
9 failed to adequately describe sufficient structure, for performing the
10 “analyzing” and “automatically generating” functions recited in the means of
11 claims 181 and 225. Therefore, the claims are indefinite. Accordingly,
12 independent system claims 181 and 225 are unpatentable under 35 U.S.C.
13 §112, ¶ 2, for indefiniteness. *See Id.* at 1333, 1337-38.

14 By virtue of their dependence on one of independent claims 181 and
15 225, we also reject dependent claims 182-202 and 226-246 on the same
16 grounds.

17 Independent claim 270 recites “a plurality of benefit modules, each
18 capable of collecting data from benefit providers.” Although independent
19 claim 270 does not specifically recite the term “means,” and thus we may
20 presume that Appellant did not intend to invoke 35 U.S.C. §112, ¶ 6, such a
21 presumption can be rebutted based on prosecution history. *See Cole v.*
22 *Kimberly-Clark Corp.*, 102 F.3d at 531. Here, with regards to claims 270-
23 272, Appellant recites on page 31 of the Appeal Brief that “it is well settled
24 that the nature/form of this/these types of claim/s (i.e. means + function, step
25 + function)...” In other words, Appellant has successfully rebutted the
26 presumption by explicitly admitting that 35 U.S.C. §112, ¶ 6 does apply to

1 independent claim 270. Accordingly, we treat “modules” of independent
2 claim 270 as the means and “collecting data from benefit providers” as the
3 function.

4 Pages 12, lines 21-28 of the Specification discloses that either (1)
5 CPU 205 of central controller 200 of system 100 or (2) “any suitable data
6 structures and search routine” that “enables processor 205 to search for and
7 locate correlated benefit information” is the structure, material, or acts that
8 correspondingly performs the recited “collecting” function. As the
9 Specification does not disclose any specific algorithm that could be
10 implemented on a general purpose computer to carry out the “collecting”
11 functions, for the same reasons as set forth above with respect to
12 independent claims 181 and 225, we find that independent claim 270 is
13 unpatentable under 35 U.S.C. § 112, second paragraph.

14 Independent claim 271 recites “means for resolving said benefit
15 request...” and “means for automatically providing benefit results...” Once
16 again, as best as we can ascertain, CPU 205 of central controller 200 of
17 system 100 is the structure, material, or acts that correspondingly performs
18 the recited “resolving” and “automatically providing” functions. As the
19 Specification does not disclose any specific algorithm that could be
20 implemented on a general purpose computer to carry out the “resolving” and
21 “automatically providing” functions, for the same reasons as set forth above
22 with respect to independent claims 181, 225, and 270, we find that
23 independent claim 271 is unpatentable under 35 U.S.C. § 112, second
24 paragraph.

25 We do not reach the merits of the Examiner’s rejection of claims 270-
26 271 under 35 U.S.C. § 102(a), the rejection of claims 181, 184, 188-202,

1 228, and 232-246 under 35 U.S.C. § 103(a), or the merits of the PMA
2 reference at this time. Rather, we reverse *pro forma* the outstanding prior art
3 rejections 181, 184, 188-202, 228, 232-246, 270, and 271, because the
4 claims fail to satisfy the requirements of the second paragraph of 35 U.S.C.
5 § 112. Before a proper review of the prior art rejection can be performed,
6 the subject matter encompassed by the claims on appeal must be reasonably
7 understood without resort to speculation. *See In re Steele*, 305 F.2d at 862-
8 63; *In re Wilson*, 424 F.2d at 1385. It should be understood, however, that
9 our decision to reverse the rejections of these claims is based on the
10 indefiniteness of the claimed subject matter and does not reflect on the
11 merits of the underlying rejections.

12

13 II. Independent Method Claims 203, 247, 269, and 272

14 ISSUE

15 Whether independent method claims 203, 247, 269, and 272 recite
16 patentable subject matter in compliance with 35 U.S.C. § 101. This issue
17 turns on whether the recitation to various machines in the claims imposes
18 meaningful limits on the claims' scope?

19

20 PRINCIPLES OF LAW

21 *35 U.S.C. § 101*

22 A claimed process is patent-eligible under § 101 if: (1) it is tied to a
23 particular machine or apparatus, or (2) it transforms a particular article into a
24 different state or thing. *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008),
25 *cert. granted*, 129 S.Ct. 2735 (2009).

1 The use of a specific machine or transformation of an article must
2 impose meaningful limits on the claim's scope to impart patent-eligibility.
3 *In re Bilski*, 545 F.3d 943, 961 (Fed. Cir. 2008), *cert. granted*, 129 S.Ct.
4 2735 (2009) (*citing Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972)).

5 Whether a claim is drawn only to a fundamental principle is
6 essentially an inquiry into the scope of that exclusion; *i.e.*, whether the effect
7 of allowing the claim would be to allow the patentee to pre-empt
8 substantially all uses of that fundamental principle. If so, the claim is not
9 drawn to patent-eligible subject matter. *Bilski*, 545 F.3d at 953 (Fed. Cir.
10 *cert. granted*, 129 S.Ct. 2735 (2009) (*citing Diamond v. Diehr*, 450
11 U.S. 175, 185, 187 (1981)).

12

ANALYSIS

14 Using our authority under 37 C.F.R. § 41.50(b), we reject independent
15 method claims 203, 247, 269, and 272 under 35 U.S.C. § 101 for failing to
16 recite patentable subject matter.

17 As an initial matter, we note that none of independent method claims
18 203, 247, 269, and 272 meet the transformation prong of *Bilski*, 545 F.3d at
19 954, as even if the inputted “set of an individual's demographic, geographic,
20 and psychographic data for said individual” qualified as a particular article,
21 no transformation of this data occurs. Accordingly, our analysis will focus
22 on the machine prong.

23 The machine prong of the *Bilski* machine-or-transformation test is
24 satisfied by showing that a claimed process is “tied to a particular machine.”
25 *Bilski*, 545 F.3d at 954. We acknowledge that the non-preamble portions of
26 independent method claims 203, 247, 269, and 272 recite structure. For

1 example, independent claim 203 recites “a memory,” “a data entry device,”
2 “the system,” and “a computer network.” However, *Bilski*, 545 F.3d at 961
3 instructs that the use of a specific machine must impose meaningful limits
4 on the claim’s scope to impart patent-eligibility. The aforementioned
5 recitations of structure do not impose such meaningful limits.

6 For example, independent claim 203 recites “storing in a memory in
7 the system benefit information.” However, any “storing” of information
8 would have to occur in a memory. Accordingly, the recitation of “memory”
9 is so generic, such that anyone who performed the storing step in practice
10 would fall within the scope of these claims. Thus, the recitation of a
11 memory in the storing step is not, in fact, a limitation at all to the scope of
12 the claim, and the claim is directed, in essence, to the storing step performed
13 by any means. *See Bilski*, 545 F.3d at 953. The same analysis can be
14 applied to the “memory” of independent claim 247, and “database” of
15 independent claim 272.

16 In another example, independent claim 203 recites “inputting a set
17 of... data into said system by means of a data entry device.” However, any
18 data must, at some point, be inputted via a data entry device. Accordingly,
19 the “data entry device” does not impose any meaningful limit on the
20 inputting step. The same analysis can be applied to the “data entry device”
21 of independent claim 247.

22 Independent claim 203 also recites “operating the system to
23 analyze...” However, any analyzing operation would have to be conducted
24 on some sort of system. Thus, the “system” does not impose any meaningful
25 limit on the operating step. The same analysis can be applied to the
26 “system” of independent claim 247.

1 In a further example, independent claim 203 recites “generating a
2 message automatically to directly information said individual, at least in part
3 via a computer network.” However, “automatically” generated messages
4 would have to information a user via a computer network. Accordingly, the
5 “computer network” does not impose any meaningful limit on the generating
6 step. The same analysis can be applied to the “computer network” of
7 independent claim 272.

8 Finally, independent claim 269 recites “querying, via a data
9 submission device...” and “receiving, via a data receiving device...” By the
10 same logic as set forth above, any data querying would have to be done via a
11 “data submission device,” and any data reception would have to be done via
12 a “data receiving device.” Thus, neither the “data submission device” nor
13 the “data receiving device” imposes any meaningful limits on the either the
14 querying or receiving steps.

15 As such, we fail to find that these recitations, in the context of the
16 entire claim, require the claimed method to include a particular machine
17 such that the method qualifies as a “process” under § 101. For these
18 reasons, we find that independent method claims 203, 247, 269, and 272 do
19 not meet the test for patentable subject matter set forth in *Bilski*, 545 F.3d at
20 954, and thus do not recite patentable subject matter under 35 U.S.C. § 101.

21 By virtue of their dependence on one of independent claims 203 and
22 247, we also newly reject dependent claims 204-224 and 248-268 on the
23 same grounds.

24 We do not reach the merits of the prior art rejections of claims 203-
25 224, 247-269, and 272, our decision because we have determined that the
26 aforementioned claims on appeal do not recite patent-eligible subject matter

1 under § 101. We reverse those rejections *pro forma*. See *Diamond v. Diehr*,
2 450 U.S. 175, 188 (1981); *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir.
3 2008) (declining to reach obviousness rejection on appeal after concluding
4 many claims were non-statutory under § 101); *Bilski*, 545 F.3d at 951 n.1
5 (noting that § 101 is a threshold requirement and that the Examiner may
6 reject claims solely on that basis); *In re Rice*, 132 F.2d 140, 141 (CCPA
7 1942) (finding it unnecessary to reach rejection based on prior art after
8 concluding claims were directed to nonstatutory subject matter); *Ex Parte
9 Gutta*, 2009 WL 2563524, *15 (BPAI 2009) (per curiam) (expanded panel)
10 (precedential) (as the claims on appeal do not recite patent-eligible subject
11 matter under § 101, the prior art rejections need not be considered).

12 It should be understood, however, that our decision to reverse the
13 prior art rejections of these claims do not reflect on the merits of the
14 underlying rejections.

15

16 DECISION

17 The decision of the Examiner to reject claims 181, 184, 188-203, 206,
18 210-225, 228, 232-247, 250, 254-268, and 270-272 is reversed.

19 Using our authority under 37 C.F.R. § 41.50(b), we newly reject
20 claims 181-202, 225-246, 270, and 271 under 35 U.S.C. § 112, second
21 paragraph, for indefiniteness; and claims 203-224, 247-269 and 272 under
22 35 U.S.C. § 101 for failing to recite patentable subject matter.

23 This decision contains a new ground of rejection pursuant to 37
24 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960
25 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37

1 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this
2 paragraph shall not be considered final for judicial review.”

3 37 C.F.R. § 41.50(b) also provides that the appellants, WITHIN TWO
4 MONTHS FROM THE DATE OF THE DECISION, must exercise one of
5 the following two options with respect to the new ground of rejection to
6 avoid termination of the appeal as to the rejected claims:

7 • (1) Reopen prosecution. Submit an appropriate amendment of the
8 claims so rejected or new evidence relating to the claims so rejected,
9 or both, and have the matter reconsidered by the examiner, in which
10 event the proceeding will be remanded to the examiner

11 • (2) Request rehearing. Request that the proceeding be reheard under
12 § 41.52 by the Board upon the same record

13

14 REVERSED; 37 C.F.R. § 41.50(b)

15 mev

16

17

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